RESPONSE TO THE REJECTIONS

PRELIMINARY CONSIDERATIONS

It is believed that the basing of the underlying rejections upon straight "Double Patenting," as opposed to directing the rejection on the basis of "Obviousness-Type Double Patenting" is a fundamental error. Applicant will respond to the rejection as if it were given on both grounds (Double Patenting and Obviousness-Type Double Patenting) so as to expedite the prosecution of this Application.

The basis of a rejection under the original Double Patenting rejection is that claims in a second patent application (or patent) cover the identical invention as the claims in a first issuedPatent. *Penduit Corp. v. Dennison Mfg. Co.*, 774 F.2d 1082, 227 USPQ 337 (Fed. Cir. 1985), *remanded*, 475 U.S. 809, 229 USPQ 478 (1986), *on remand*, 810 F.2d 1561, 1 USPQ 2d 1593 (Fed. Cir. 1987. The critical element of the rejection was that the **claims** cover essentially the identical (word-for-word comparison) invention. The only variation in claim language that was originally allowed under the Doctrine of Double Patent was for mere "colorable differences." For example, it was still considered Double Patenting if a first Patent issued for a hammer and a second Application had an identical claim for a blue hammer. See *In re Longi*, 759 F.2d 887; 225 USPQ 645 (Fed. Cir. A985); and *In re Kaplan*; 789 F.2d 1574, 229 USPQ 678 (Fed. Cir. 1986) for the background and distinctions between Double Patenting and Obviousness-Type Double Patenting.

Obviousness-Type Double Patenting exists where claims in a second Patent (or pending application) differ from claims in a first Patent in a substantive manner, but that difference is asserted or found to be obvious (in accordance with 35 USC 103(a)) on the basis of prior art defined in the rejection or assertion. *In re Dembiczak*, 175 F.3d 994, 50 USPQ2d 1614 (Fed. Cir. 1999).

In the present rejections, Applicants will show that claimed subject matter in the respective Patents is not identical, but rather at worst (without yet acknowledging a worst case scenario) would be claimed subject matter that is obvious in view of secondary art over the claims of the earlier Patents and copending Applications. This worst case scenario would allow the present claims to be patented with the filing of a Terminal Disclaimer in the present Application over each of the Patents and Applications used in the rejection. This is being done to expedite the prosecution of this Application as any Patent issuing from this Application would already expire on the same date as the earliest

Patent cited would expire because of the claim for priority in the present Application that extends back under 35 USC 120 to the earliest of the U.S. Patents.

1. Claims 1-45 have been rejected under the Judicially-Created Doctrine of Double Patenting over U.S. Patents Nos. 5,288,081; 5,437,462; 6,019,374; 6,273,424; and 6,454,266.

Applicants provide below a side-by-side comparison of the present claim 1 with the issued claim 1 in each of these Patents to exemplify the difference in the scope of claims:

PRESENT CLAIM 1	**CLAIM 1 OF U.S. PATENT 5,288,081**	**COMMENTS**
A method of playing a wagering card game for a number of player using standard playing cards having a standard rank,	1. A method of playing a wagering card game for a number of player using standard playing cards having a standard rand [*sic*, rank],	
said game involving standard poker hand rankings and comprising the steps of:	said game involving standard poker hand rankings and comprising the steps of:	
each player placing at least four distinct wagering parts to participate in the game;	each player placing a wager to participate in the game;	**A four part wager is not identical to a wager.**
dealing three cards to each player and at least two common cards, all of said at least two common cards being dealt face down;	dealing cards to each player and at least one common card, all of said cards being dealt face down;	**These limitations also have distinct scope differences.**
giving each player the chance to examine the cards received by that	giving each player the chance to examine the cards received by that player and	

player and to withdraw at least a first part of said at least four distinct wagering parts wager based on the rank of said player's cards prior to one of said at least two common cards being dealt face down being exposed;	to withdraw at least part of said wager based on the rank of said player's cards;	
showing said at least one common card, thereby providing at least a partial hand for each player, each player's at least a partial hand comprising said shown at least one common card and the cards each player was dealt;	showing said at least one common card, thereby providing a hand for each player, each player's hand comprising said shown at least one common card and the cards each player was dealt; and	
allowing each player to withdraw a second part of the at least four wagering parts and forfeiting a third part of the at least four wagering parts;		**This betting play format is absent from the claim. It is a distinctly different and rigid format.**
showing at least one more common card to expose all common cards that had been dealt face down; and		**This limitation is within other claims of 5,288,081.**
Resolving each player's remaining wager based on the rank of that player's hand, which remaining	resolving each player's remaining wager, which was not withdrawn based on the rank of that player's	

wager was not withdrawn.	hand.	

As can be seen, there are substantive claim differences that in a worst case scenario, with teachings other theoretic art, could be asserted to be obvious, but which are not identical (in a Double Patenting sense) to the limitations in the scope of claims between this Application and US Patent 5,288,081. As no art evidencing obviousness has been made of record, there is no basis for even asserting and Obviousness-Type Double Patenting rejection between the present application and US Patent No. 5,288,081. This rejection is clearly in error.

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PRESENT CLAIM 1	**CLAIM 24 OF U.S. PATENT 6,019,374**	**COMMENTS**
A method of playing a wagering card game for a number of player using standard playing cards having a standard rank,	24. A method for playing a wagering game,	Claim 24 has been selected as this claim is broader than most other claims in the Patent. This patent otherwise tends to be directed towards tournament play of games.
said game involving standard poker hand rankings and comprising the steps of:	characterized by a basic game, a basic game payoff and a jackpot payoff, comprising the steps of:	**The basic game of the Application may include these steps.**
each player placing at least four distinct wagering parts to participate in the game;	placing a basic wager to become a participant in the basic game; paying an entry fee to become a participant eligible to win the jackpot payoff;	**No entry fee is claims in the present Application. There are not four distinct wagers in the game that are claimed in the Patent.**
dealing three cards to each player and at least	playing the basic game;	**The basic games, e.g., Let It Ride® poker may be the**

two common cards, all of said at least two common cards being dealt face down;		**same.**
giving each player the chance to examine the cards received by that player and to withdraw at least a first part of said at least four distinct wagering parts wager based on the rank of said player's cards prior to one of said at least two common cards being dealt face down being exposed;		
showing said at least one common card, thereby providing at least a partial hand for each player, each player's at least a partial hand comprising said shown at least one common card and the cards each player was dealt;		
allowing each player to withdraw a second part of the at least four wagering parts and forfeiting a third part of the at least four wagering parts;		
showing at least one more common card to expose all		

common cards that had been dealt face down; and		
resolving each player's remaining wager based on the rank of that player's hand, which remaining wager was not withdrawn.	resolving the basic wager based on the outcome of the basic game, wherein if the participant meets a range of game conditions, the participant wins an amount in accordance with a payable in turn based on a proportionate payout; resolving the entry fee, wherein if the participant meets a predetermined narrower range of game conditions, the participant becomes eligible to win the jackpot payoff; and playing a second game to select a winner of the jackpot payoff.	**The scope of difference between these claims is so extreme that further attempts at comparison of claim scope are nearly preposterous. There are few similarities between the claims.**

As can be seen, there are substantive claim differences that in a worst case scenario, with teachings other theoretic art, could be asserted to be obvious, but which are not identical (in a Double Patenting sense) to the limitations in the scope of claims between this Application and US Patent 6,019,374. As no art evidencing obviousness has been made of record, there is no basis for even asserting and Obviousness-Type Double Patenting rejection between the present application and US Patent No. 6,019,374. This rejection is clearly in error.

PRESENT CLAIM 1	CLAIM 1 OF U.S. PATENT 5,437,462	COMMENTS
A method of playing a wagering card game for a number of player using standard playing cards having a standard rank,	1. A method of playing a wagering card game using actual or representations of standard face playing cards having a standard rank,	
said game involving standard poker hand rankings and comprising the steps of:	said game involving standard poker hand rankings and comprising the steps of:	**Standard poker hands may be used in other claims.**
each player placing at least four distinct wagering parts to participate in the game;	a player placing a wager to participate in the game;	**There are no four part wagers claimed.**
dealing three cards to each player and at least two common cards, all of said at least two common cards being dealt face down;	providing cards for the player;	
giving each player the chance to examine the cards received by that player and to withdraw at least a first part of said at least four distinct wagering parts wager based on the rank of said player's cards prior to one of said at least two common cards being	giving the player the chance to examine the cards received by the player and to withdraw at least part of said wager based on the rank of the player's cards;	**There are no four part wagers to be considered with this strict rule of play. There are only three parts shown in the Patent.**

dealt face down being exposed;		
showing said at least one common card, thereby providing at least a partial hand for each player, each player's at least a partial hand comprising said shown at least one common card and the cards each player was dealt;	showing the player at least one common card, thereby providing a hand for the player, the player's hand comprising said shown at least one common card and the cards the player received;	
allowing each player to withdraw a second part of the at least four wagering parts and forfeiting a third part of the at least four wagering parts;		**This strict rule of play is not claimed. The claims allow only for withdrawing 2/3 wager parts before individual community cards are revealed.**
showing at least one more common card to expose all common cards that had been dealt face down; and		**There is no claim of an additional common card being exposed after withdrawal and forfeiture.**
resolving each player's remaining wager based on the rank of that player's hand, which remaining wager was not withdrawn.	and resolving the player's remaining wager, which was not withdrawn, based on the rank of the player's hand.	

As can be seen, there are substantive claim differences that in a worst case scenario, with teachings other theoretic art, could be asserted to be obvious, but which are not identical (in a Double Patenting sense) to the limitations in the scope of claims between this Application and US Patent 5,437,462. As no art evidencing obviousness has been made of record, there is no basis for even asserting and Obviousness-Type Double Patenting

rejection between the present application and US Patent No. 5,437,462. This rejection is clearly in error.

PRESENT CLAIM 1	CLAIM 1 OF U.S. PATENT 6,273,424	COMMENTS
A method of playing a wagering card game for a number of player using standard playing cards having a standard rank,	1. A method of playing a wagering game comprising	
said game involving standard poker hand rankings and comprising the steps of:		**Standard poker hands may be used in other claims.**
each player placing at least four distinct wagering parts to participate in the game;	a player placing a wager comprising at least two distinct parts and	**There are no four part wagers claimed.**
dealing three cards to each player and at least two common cards, all of said at least two common cards being dealt face down;	providing to the player at least a portion of the player's game elements so that partial information or a game outcome is provided,	
giving each player the chance to examine the cards received by that player and to withdraw at least a first part of said at least four distinct wagering parts wager based on the rank of said player's cards prior to one of said at least	giving the player at least one opportunity, before the player's final game outcome is determined, to withdraw from engagement in the game at least one part of said at least two parts, but less than all of said at least two parts, and	**There are no four part wagers to be considered with this strict rule of play.**

two common cards being dealt face down being exposed;		
showing said at least one common card, thereby providing at least a partial hand for each player, each player's at least a partial hand comprising said shown at least one common card and the cards each player was dealt;		
allowing each player to withdraw a second part of the at least four wagering parts and forfeiting a third part of the at least four wagering parts;		**This strict rule of play is not claimed.**
showing at least one more common card to expose all common cards that had been dealt face down; and	continuing play of the game with additional portions of the player's game elements being displayed to the player.	
resolving each player's remaining wager based on the rank of that player's hand, which remaining wager was not withdrawn.		

As can be seen, there are substantive claim differences that in a worst case scenario, with teachings other theoretic art, could be asserted to be obvious, but which are not identical (in a Double Patenting sense) to the limitations in the scope of claims between this Application and US Patent 6,273,424. As no art evidencing obviousness has been made

of record, there is no basis for even asserting and Obviousness-Type Double Patenting rejection between the present application and US Patent No. 6,273,424. This rejection is clearly in error.

PRESENT CLAIM 1	**CLAIM 67 OF U.S. PATENT 6,454,266**	**COMMENTS**
A method of playing a wagering card game for a number of player using standard playing cards having a standard rank,	67. A method of playing a game comprising a set of rules, the method comprising:	**All other independent claims in this Patent are directed to a game or apparatus using a "wild card." That limitation is not present in the claims of this Application.**
said game involving standard poker hand rankings and comprising the steps of:	a player placing a wager comprising at least two bet segments to participate in the game;	**Poker games are claimed.**
each player placing at least four distinct wagering parts to participate in the game;	providing the player with information useful as a partial indication of a game outcome;	
dealing three cards to each player and at least two common cards, all of said at least two common cards being dealt face down;		**The game of "Let It Ride®" poker is claimed, which follows these rules.**
giving each player the chance to examine the cards received by that	the player optionally withdrawing at least one but not all bet segments from	**There are no four part wagers claimed.**

player and to withdraw at least a first part of said at least four distinct wagering parts wager based on the rank of said player's cards prior to one of said at least two common cards being dealt face down being exposed;	play;	
showing said at least one common card, thereby providing at least a partial hand for each player, each player's at least a partial hand comprising said shown at least one common card and the cards each player was dealt;		
allowing each player to withdraw a second part of the at least four wagering parts and forfeiting a third part of the at least four wagering parts;		**This strict wagering procedure is not claimed in the Patent.**
showing at least one more common card to expose all common cards that had been dealt face down; and	completing play of the game; and	
resolving each player's remaining wager based on the rank of that player's hand, which remaining wager was not withdrawn.	providing the player a prize when the player's game outcome is a winning game outcome according to the set of rules.	

As can be seen, there are substantive claim differences that in a worst case scenario, with teachings other theoretic art, could be asserted to be obvious, but which are not identical (in a Double Patenting sense) to the limitations in the scope of claims between this Application and US Patent 6,454,266. As no art evidencing obviousness has been made of record, there is no basis for even asserting and Obviousness-Type Double Patenting rejection between the present application and US Patent No. 6,454,266. This rejection is clearly in error.

As can be readily seen, all rejections purported to be based upon the Judicially-Created Doctrine of Double Patenting are in error. These rejections must be withdrawn. If rejection under the Judicially-Created Doctrine of Obviousness-Type Double Patenting is subsequently asserted, specific prior art that shows why the differences between the claims of the Patents and the claims of the present application are obvious. In view of the fact that the record fails to establish any basis for double patenting. Therefore, no Terminal Disclaimer is filed with this Amendment.

2. Claims 1-45 have been Provisionally Rejected under the Judicially-Created Doctrine of Double Patenting over U.S. Patent Applications 10/293,044; 10/286,440; and 10/293,074.

This is of course a provisional rejection, as no claims have issued in this or the cited Applications. Applicant asserts that the claims in the cited commonly assigned applications are also, as a worst case scenario, only rejectable under the Judicially-Created Doctrine of Obviousness-Type Double Patenting, and not as Double Patenting. To assure that even the worst case scenario is addressed by this Amendment and Response, Applicant submits herewith a separate Terminal Disclaimer directed towards U.S. Patent Applications 10/293,044, and in the absence of a difference of claim scope, one of the applications will be abandoned upon allowance of the other application, preferably abandoning the earlier application, US Patent Application Serial No. 10/293,044.

Even the potential for a rejection under those grounds is obviated by this action, even though Applicant finds no basis whatsoever for the holding of even provisional double patenting from two of these references, 10/286,440; and 10/293,074.

For example, just looking at claim 1 of 10/293,044, the subject matter, bears no resemblance to a four part bet with a forfeiture of the third part when the second part is withdrawn. That concept is completely absent from the claims.

1. A method of playing a casino table wagering game with at least two players comprising: wagering on an underlying game where players may receive a payout for obtaining a player hand of at least a predetermined rank; placing a side bet that at least one player of the at least two players will obtain a player hand of at least a predetermined rank; playing a hand of the casino table wagering game to conclusion; determining if at least one of the at least two players has obtained a player hand of said at least a predetermined rank; if at least one player has obtained a player hand of at least a predetermined rank, awarding each player who placed the side bet a predetermined proportional share of the bonus for obtaining a player hand of at least a predetermined rank.

As can be seen, there is absolutely no basis from the reference alone for asserting double patenting or obviousness-type double patenting from Claim 1 or any other combination of claims in the Patent.

Similarly with respect to 10/286,440, the first claim in that application reads:

1. A method of playing a casino table wagering game with at least two players comprising: wagering on an underlying game where players may receive a bonus for obtaining a player hand of at least a predetermined rank; placing a side bet that at least one player of the at least two players will obtain a player hand of at least a predetermined rank; playing a hand of the casino table wagering game to conclusion; determining if at least one of the at least two players has obtained a player hand of said at least a predetermined rank; if a player has not obtained a player hand of at least a predetermined rank, but that player has placed the side bet that at least one player of the at least two players will obtain a player hand of at least a predetermined rank, and if another player has obtained a player hand of at least a predetermined rank, awarding that player a predetermined proportional share of the bonus for obtaining a player hand of at least a predetermined rank.

As can be readily seen again, there is absolutely no basis from the reference alone for asserting double patenting or obviousness-type double patenting from Claim 1 or any other combination of claims in the Patent.

CONCLUSION

The two rejections under the Judicially-Created Doctrine of Double Patenting have been shown to be in error. The potential provisional rejections under the Judicially-Created Doctrine of Obviousness-Type Double Patenting have not been substantiated on the record by the citation of art that would establish that the rejections would be reasonably asserted against the present claims. This Amendment is accompanied by a Petition under 37 CFR 1.54(c) to correct the claim of priority.

Respectfully submitted,

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